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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,504	04/27/2001	Mark Wayne Domanico	001441	9052
22876	7590	08/12/2003		
FACTOR & PARTNERS, LLC 1327 W. WASHINGTON BLVD. SUITE 5G/H CHICAGO, IL 60607			EXAMINER	
			NGUYEN, THU KHANH T	
			ART UNIT	PAPER NUMBER
			1722	11
DATE MAILED: 08/12/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/844,504	DOMANICO, MARK WAYNE
	<b>Examiner</b>	<b>Art Unit</b>
	Thu Khanh T. Nguyen	1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 21 July 2003.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-26 is/are pending in the application.

4a) Of the above claim(s) 14-26 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-12 is/are rejected.

7) Claim(s) 13 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-10 and 12 are again rejected under 35 U.S.C. 102(b) as being anticipated by Kott et al (4,750,967).

Kott et al teach an apparatus for forming a liner on a washbasin, comprising a container (60) defining a cavity (86), a seal (72, 56) forming a continuous seal with a bathtub liner (50), an electric heating element (78; col. 11, lines 63-65) which is located inside the top wall of the cavity, means for increasing pressure (a negative pressure, 96) to force the bathtub liner outwardly, away from the cavity and cover the bathtub, wherein the container (60) includes a top surface (76) and a plurality of side walls (82, col. 12, lines 8), which associated with the top surface (col. 12, lines 4-10) and defines a lower perimeter of the container, and the seal member (72) extending about the perimeter of the side walls (col. 10, lines 12-16); a portion (82) of the container comprises a transparent member (84) for visual inspection of the cavity (col. 13, lines 14-16).

The apparatus further comprises a kit of a plurality of width and length compensating members (62), in which the length of the kit is adjustable (col. 9, lines 45-54) to accommodate varying lengths of the bathtub, and the weight of the container pressing down on the liner enhancing the effectiveness of the seal member (col. 9, lines 3-5).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 11 is again rejected under 35 U.S.C. 103(a) as being unpatentable over Kott et al ('967) as applied to claims 1-10 and 12 above, and further in view of Niebling et al (5,217,563).

Kott et al disclose a molding apparatus as described above, but fail to disclose an air compressor that is in fluid communication with the cavity of the container.

Niebling et al disclose a sheet forming apparatus comprising an air compressor (4), which is in fluid communication with a mold cavity (8) for pushing the sheet against a forming surface (6) during the molding process.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Kott et al by replacing the vacuum by the air compressor as taught by Niebling et al because when using the air compressor the sheet would be pushed against the forming surface without the need of drilling a hole in the bathtub to form an evacuation hole as in the case of using a vacuum.

***Allowable Subject Matter***

5. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 1722

6. The following is a statement of reasons for the indication of allowable subject matter: the prior art fails to teach or suggest an apparatus for forming a bathtub liner comprising a container defining the molding cavity for thermoforming a sheet into the liner, a seal forming a continuous seal with the bathtub liner, a weight on the container to facilitate the sealing of the seal member, in which the weight comprises a fluid container having at least one inlet and outlet to control the amount of fluid inside the fluid container.

***Response to Arguments***

7. Applicant's arguments filed July 24, 2003 have been fully considered but they are not persuasive.

The Applicant has argued that Kott ('967) fails to disclose means for increasing the pressure within the cavity of a container to force the bathtub liner outwardly away from the cavity. Kott, however, discloses means (96) for creating a vacuum within a cavity. The vacuum is a negative pressure; therefore, if there is a means to create a vacuum, there also is a means to increase the pressure (could be positive pressure or could be negative pressure) within the cavity.

The Applicant further alleged that the pressure means has to force the bathtub liner outwardly away from the cavity. However, this is the indented use of the apparatus, which has little or no patentable weight in an apparatus claim. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device *is*, not what a device *does*." Hewlett- Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (Emphasis in original)

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Khanh T. Nguyen whose telephone number is 703-305-7167. The examiner can normally be reached on Monday- Friday, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

TN  
July 31, 2003

*Robert Davis*  
ROBERT DAVIS  
PRIMARY EXAMINER  
GROUP 1300 1700

8/7/03